REMARKS

In this Response claims 2, 3, 13, 19, and 36 have been amended and claims 4, 18, 30 – 33, and 38 have been cancelled without prejudice. Support for these amendments is found throughout the originally filed specification.

Claims 2, 3, 6 – 16, 19 – 23, and 34 – 37 remain pending.

Claim Rejections – 35 USC 112

Claims 4 and 18 – 23 are rejected under 35 USC 112, second paragraph, as being indefinite. Specifically, it is alleged that it is contradictory to have a further limitation that requires different surfaces to be on the same surfaces. The Applicants have presented cancellations and amendments to clarify the claim language.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claim Rejections – 35 USC § 102

In the Office Action claims 2 – 3, 6 – 8, 11 – 12, 25, 27, 34, and 37 are rejected under 1-33 are rejected under § 102(e) as being anticipated by Pokharna (US 6,801,430) (hereinafter "Pokharna"). The Applicants traverse this rejection.

In the rejection of these claims, the Examiner states that "it is inherent to produce an apparatus having a case within the electronic field that is compatible with industry standards." The Applicants traverse this statement of inherency.

The requirements of making a rejection based on inherent teachings of prior art are discussed in MPEP 2112. In this section it is stated that to rely "upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows *from the teachings of the applied prior art.*" *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (underlining emphasis in original, italicized emphasis added). That is, the art relied upon to supply every other limitation of a rejected claim must inherently disclose the missing limitation.

Applying this law to the present situation, it is clear that the Examiner is required to show that it is inherent that the case of Pokharna's portable computer system **202** is

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